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09/976,880	10/11/2001	Margaret Motamed	EFIM0070C	2558

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EXAMINER
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VIDA, MELANIE M

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 09/29/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/976,880

Applicant(s)

MOTAMED, MARGARET

Examiner

Melanie M Vida

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other:

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement(s) (IDS) submitted on 1/6/03 has been considered by the examiner and is attached to this office action.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 1-20** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 12, and 25 of U.S. Patent No. 6,327,047.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

**Claim 1**, as recited in the application, "the method of automatically calibrating a scanner, comprising the steps of affixing a calibration target to a scanning surface of said scanner, and calibrating said scanner with said calibration target during a normal scan", is not patentably distinct from the method and steps of claim 1 in the patent with respect to the methods and steps for calibrating a scanner for an object during a normal scan, (col. 8, lines 10-17). **Claim 2** as

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recited in the application for the scanner and a platen with a calibration target, is identical to claim 2 in the patent, (col. 8, lines 18-22). **Claim 3**, as recited in the application, for the calibration target is identical as recited in claim 2, in the patent, (col. 8, lines 22-24). **Claim 4**, the calibration target characteristic, as recited in the application, is identical to claim 4 in the patent, (col. 8, lines 25-26). **Claim 5**, the calibration target strip, as recited in the application, is identical to claim 5 in the patent, (col. 8, lines 27-29). **Claim 6**, the calibration target characteristic, as recited in the application is identical to claim 6 in the patent, (col. 8, lines 30-37). **Claim 7**, a calibration target characteristic, as recited in the application is identical to claim 7 in the patent, (col. 8, lines 38-45). **Claim 8**, a calibration target characteristic, as recited in the application is identical to claim 8 in the patent, (col. 8, lines 45-47). **Claim 9**, the characteristic of the calibration target, as recited in the application is identical to claim 9 in the patent, (col. 8, lines 48-49). **Claim 10**, a scanner comprising a plastic non-reflective sleeve is not patentable distinct from claim 12 in the patent, (col. 8, line 66 through col. 9, line 2). Regarding, **claims 11-19**, please refer to the corresponding rejection in claims 1-10 above. Regarding, **claim 20** the method for calibrating a printer using a scanner is not patentably distinct from claim 25 in the patent, (col. 9, line 60 through col. 10, line 6).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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**Claim 20** is rejected under 35 U.S.C. 102(b) as being anticipated by Wan et al. (USP 5,452,112, hereinafter, Wan), as cited by the applicant.

Regarding, **claim 20**, Wan teaches, as shown in figure 3, a method to calibrate a printer with a scanner, which reads on “a method for calibrating a printer using a scanner”, (col. 3, lines 45-51). Further, Wan teaches the operator first scans the scanning target H to produce a first test file (step 58), which reads on “attaching a calibration target strip to said scanner”, (col. 4, lines 54-56). The scanned image file is printed to produce a test pattern (Tpj), which reads on “printing calibration target”, (step 66). Wan teaches that the printed test pattern (Tpj) is scanned (72), which reads on “placing said printed calibration target on said scanner”, “scanning said printed calibration target on said scanner”. The scanned test pattern (Tpj) is processed by comparing it to the scanner calibration table to produce a second test file, used to calibrate a printer (step 72-73), which reads on “calibrating said printer using said scanned printed calibration target.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. **Claims 1-3, 11-12, 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchar (USP 4,618,248, hereinafter Buchar), as cited by the applicant, as cited by the applicant, and further in view of Takase (USP 5,249,068, hereinafter, Takase).

Regarding, **claim 1**, Buchar teaches a flow diagram of the patch generation portion of the automatic setup procedure, as shown in figures 4a-4b, which reads on “a method for automatically calibrating a scanner”, (col. 6, lines 34-39). Target strips (92, 107) of varying density are affixed to the bottom of a platen so that variable parameters are adjusted to maintain optimum operation, which reads on “affixing a calibration target to a scanning surface of said scanner”, (col. 1, lines 5-10; fig. 5).

Buchar does not expressly disclose “calibrating said scanner with said calibration target during a normal scan”.

However, Takase, as shown in figure 2A, a waveform output from the line sensor (1), comprising WB, a waveform of a signal outputted by a photoelectric conversion elements when reading the reference white board provided outside the effective image reading range of an original document for one main scan, the effective reading range of the original document is scanned by the line sensor (1), which reads on “calibrating said scanner with said calibration target during a normal scan”, (col. 6, lines 31-34; lines 45-49).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Buchar’s scanner calibration method with Takase’s teachings of scanning a target with an original in a main scan direction.

One of ordinary skill in the art would have been motivated to scan a target image with an original in a main scan direction because the illumination of light by the optical lighting part varies, given the express suggestion of Takase, (col. 7, lines 53-59).

Regarding, **claim 2**, Buchar teaches an electro photographic printing machine and scanning system with a platen for supporting the document, which reads on “said scanner comprises a platen”, (col. 2, lines 30-38). The calibration target (92), as shown in figure 5, centrally overlies the scan carriage, which reads on “said calibration target comprises a width of approximately or equal to a length of a width of said platen”, (col. 6, lines 60-63).

Regarding, **claim 3**, Buchar inherently teaches, “calibration target is a Kodak Gray Strip, an IT8 target, or an equivalent manufactured calibration target”, as evidenced by the density target strip (107), (col. 8, line 16).

Regarding, **claim 11**, please refer to claim 1.

Regarding, **claim 12**, please refer to claim 2.

Regarding, **claim 13**, please refer to the corresponding rejection in claim 3.

6. **Claims 4 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchar (USP 4,618,248, hereinafter Buchar), as cited by the applicant, and further in view of Takase (USP 5,249,068, hereinafter, Takase), as applied to claim 1, and claim 11 respectively, above, and further in view of Green et al. (USP 5,481,480, hereinafter, Green).

Regarding, **claim 4**, Buchar in view of Takase teaches the method of claim 1, but fails to expressly disclose, “The calibration target comprises a photograph on photographic paper”.

However, Green teaches that the control strip, which reads on the “calibration target” has 21 densities in steps of 0.15 log exposure units with light of a colour appropriate to the type of

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film being used for process control, which reads on “comprises a photograph” produced by taking a small piece of film, which reads on “photographic paper”, (col. 1, lines 26-31).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Buchar in view of Takase scanner calibration method with Green’s control strip made of photographic film containing a photographic image.

One of ordinary skill in the art would have been motivated to use a control strip made from photographic film in order to use an appropriate type of film being used for process control, given the express suggestion of Green, (col. 1, lines 29-32).

Regarding, **claim 14**, please refer to the corresponding rejection in claim 4.

7. **Claims 5 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchar (USP 4,618,248, hereinafter Buchar), as cited by the applicant, and further in view of Takase (USP 5,249,068, hereinafter, Takase), as applied to claim 1, and claim 11, above, and further in view of Thompson (USP 6,143,454).

Regarding, **claim 5**, Buchar in view of Takase teaches the method of claim 1 with a calibration target, but fails to expressly disclose, “The calibration target strip comprises a dye sublimation print on photographic paper or paper equivalent to photographic”.

However, Thompson inherently teaches “a dye sublimation print onto a photographic paper or paper equivalent to photographic”, as evidenced by a color toner containing sublimation dyes, which can be applied to a secondary substrate, made of any material, (col. 4, lines 25-27; lines 36-39).



At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Buchar in view of Takase, calibration target and method with Thompson's teachings of using a calibration target with dye sublimation print onto a photographic material.

One of ordinary skill in the art would have been motivated to use a control strip with sublimation dyes on a photographic material, because the secondary substrate can be made of any material, given the express suggestion of Thompson, (col. 1, lines 25-27).

Regarding, **claim 15**, please refer to the corresponding rejection in claim 5.

8. **Claims 6, 10, 16, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchar (USP 4,618,248, hereinafter Buchar), as cited by the applicant, and further in view of Takase (USP 5,249,068, hereinafter, Takase), as applied to claim 1, and claim 11, respectively above, and further in view of Ryu, (USP 6,295,386 B1, hereinafter, Ryu).

Regarding, **claim 6**, Buchar in view of Takase teaches the method of claim 1, but fails to expressly disclose "the calibration target comprises: a plastic material, said plastic material having an adhering surface and a covering over said adhering surface such that the adhering surface allows the plastic material to adhere to a part of the scanner when the covering is removed from the adhering surface."

However, Ryu inherently teaches "the calibration target comprises: a plastic material having an adhering surface and a covering over said adhering surface such that the adhering surface allows the plastic material to adhere to a part of the scanner when the covering is removed from the adhering surface" as evidenced by the pattern of a reference sticker, R, attached to an end portion of a scanning area, (col. 1, lines 41-46).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Buchar in view of Takase scanner calibration method with Ryu plastic reference sticker as the calibration target.

One of ordinary skill in the art would have been motivated to use a plastic reference sticker in order to correct the image errors according to conventional prior art, given the express suggestion of Ryu, (col. 1, lines 40-42).

Regarding, **claim 16**, please refer to the corresponding rejection in claim 6.

Regarding, **claim 10**, Buchar in view of Takase teaches the method of claim 1, but fails to expressly disclose “the scanner further comprises a plastic non-reflective sleeve located proximate to a scanning surface for fixedly holding said calibration target in said sleeve”.

However Ryu inherently teaches “the scanner further comprises a plastic non-reflective sleeve” as evidenced by a using a precise apparatus for attaching a reference sticker to prevent error due to failing to properly attach the reference sticker to the scanner and using a clean cover so that the sticker is not degraded by image errors, (col. 1, lines 57-60; lines 59-62). Further, it is inherently taught that “the non-reflective sleeve located proximate to a scanning surface for fixedly holding said calibration target in said sleeve”, as evidenced by using a precise apparatus to secure a reference sticker to correct the error due to failing to properly attach the reference sticker to the scanner, and that the reference sticker, R is attached to the end portion of an effective scanning error as shown in figure 1, (col. 1, lines 41-44, lines 57-60).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify Buchar in view of Takase, scanner calibration method with Ryu’s teachings of a cover with precise apparatus for attaching a calibration target at the end of a scanner. One of

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ordinary skill in the art would have been motivated to use a transparent sleeve to prevent image degradation errors from reading a calibration strip, given the express suggestion of Ryu, (col. 60-63).

9. **Claims 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchar (USP 4,618,248, hereinafter Buchar), as cited by the applicant, and further in view of Takase (USP 5,249,068, hereinafter, Takase), as applied to claim 1 above, and further in view of Thompson (USP 6,143,454), and further in view of Ryu, (USP 6,295,386 B1, hereinafter, Ryu).

Regarding, **claim 7**, Buchar in view of Takase teaches the method of claim 1 with a calibration target, but fails to expressly disclose, “a dye sublimation print onto a plastic material”.

However, Thompson inherently teaches “a dye sublimation print onto a plastic material”, as evidenced by a color toner containing sublimation dyes, which can be applied to a secondary substrate, made of any material, (col. 4, lines 25-27; lines 36-39).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Buchar in view of Takase scanner calibration method with Thompson’s teachings of using a calibration target with dye sublimation print onto a plastic material.

One of ordinary skill in the art would have been motivated to use a control strip comprised of sublimation dyes on a plastic material, because it is suitable for electrostatic recording and printing processes, given the express suggestion of Thompson, (col. 1, lines 6-9).

Buchar in view of Takase and further in view of Thompson do not expressly disclose, “said plastic material having an adhering surface and a covering over said adhering surface such

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that the adhering surface allows the plastic material to adhere to a part of the scanner when the covering is removed from the adhering surface”.

However, Ryu inherently teaches “the calibration target comprises: a plastic material having an adhering surface and a covering over said adhering surface such that the adhering surface allows the plastic material to adhere to a part of the scanner when the covering is removed from the adhering surface” as evidenced by the pattern of a reference sticker, R, attached to an end portion of a scanning area, (col. 1, lines 41-46).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Buchar in view of Takase and further in view of Thompson scanner calibration method with Ryu plastic reference sticker as the calibration target.

One of ordinary skill in the art would have been motivated to use a plastic reference sticker in order to correct the image errors according to conventional prior art, given the express suggestion of Ryu, (col. 1, lines 40-42).

10. **Claims 8 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchar (USP 4,618,248, hereinafter Buchar), as cited by the applicant, and further in view of Takase (USP 5,249,068, hereinafter, Takase), as applied to claim 1 and claim 11 above, and further in view of Telser et al. (USP 6,326,128 B1, hereinafter Telser).

Regarding, **claim 8**, Buchar in view of Takase teaches the method of claim 1, but fails to expressly disclose, “the step of: providing a calibration target having a protective coating”.

However, Telser, inherently teaches “the step of: providing a calibration target having a protective coating”, as evidenced by a step to remove a protective cover from the test strip, (col. 5, lines 54-56).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify Buchar in view of Takase's scanner calibration method with Telser's protective coating.

One of ordinary skill in the art would have been motivated to use a protective coating on the calibration target, to prevent fingerprints from contaminating the calibration strip and errors during calibration.

Regarding, **claim 17** please refer to the corresponding rejection in claim 8.

11. **Claims 9 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchar (USP 4,618,248, hereinafter Buchar), as cited by the applicant, and further in view of Takase (USP 5,249,068, hereinafter, Takase), as applied to claim 1 and claim 11 above, and further in view of Neiman, (USP 5,698,287, hereinafter, Neiman).

Regarding, **claim 9**, Buchar in view of Takase teaches the method of claim 1 and a calibration target, but does not expressly disclose that the calibration target comprises decal paper.

However, Neiman discloses of printing a scanned image on decal paper suitable to apply to a ceramic, (col. 3, lines 12-15).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Buchar in view of Takase scanner calibration target with Neiman's method of printing an image onto decal paper.

One of ordinary skill in the art would have been motivated to create a calibration target out of decal paper because it uses a glue or adhesive to prevent the migration of pigments imprinted by the printer, given the express suggestion of Neiman, (col. 3, lines 15-17).

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Regarding, **claim 18**, please refer to the corresponding rejection in claim 9.

*Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Appel et al USP 5,313,219, a method to calibrate a printer using a scanner.

Johnston et al. USP 5,241,406 a flat bed scanner for transparency machines.

Tesler et al. USP 6,326,128, decal paper as a photosensitive recording material.

Falk USP 6,141,120, a color calibration method-using scanner profiles.

Dundas et al. USP 5,604,567 a printer color and gray balance adjustment system.

Williams et al. USP 5,642,202 a method to calibrate a printer using a scanner (fig. 1, col. 1, lines 31-46).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie M Vida whose telephone number is (703) 306-4220. The examiner can normally be reached on 8:30 am 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

*MMV*  
MMV  
September 11, 2003

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